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| 09/829,645      | 04/09/2001  | Kulbir S. Sandhu     | M-9710 US           | 7663             |

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EXAMINER

ISSING, GREGORY C

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3662

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/829,645

Applicant(s)

SANDHU ET AL.

Examiner

Gregory C. Issing

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-3, 6-11, 14-17, 19-21, 23, and 26-29 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Sakuma.

Sakuma discloses the claimed system for providing a first mobile phone with location information of a second mobile phone wherein each mobile phone registers with a location database that stores the locations of all registered mobile phones. Upon request by a first mobile phone, the location of the second mobile phone is provided. Additionally, map information may be communicated by the location database along with the location information (Note: JP 10 094028 A corresponds to the Japanese equivalent to the cited US patent and was published April 10, 1998). There is nothing that patentably distinguishes the interconnected nodes between which information is downloaded and retrieved via communication links in Sakuma and the claimed “internet”/“service provider”.

3. Claims 1-3, 6-11, 13-17, 19-23, and 26-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Bar et al.

Bar et al disclose a database/database server that maintains a dynamic database of current cellular (mobile) users, including identification and location. The central server may be accessed

by third-party subscribers or the users themselves. Upon receiving a query from a subscriber (or user), the server accesses the database and sends a response providing real-time location based information/services.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Sakuma or Bar et al in view of Amro et al.

6. Each of Sakuma and Bar et al teach the subject matter substantially as claimed as previously set forth above but fail to teach the use of GPS receivers in the mobile users to provide the mobile user position. Rather each uses an alternative, known position determining method. Amro et al teach the conventionality of mobile users associated with a wireless network and desiring location based information to utilize a conventional GPS receiver to provide the user self-position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either one of Sakuma or Bar et al by integrating a conventional GPS receiver within the communication device to provide accurate position information at a low cost in view of the dominance of GPS as an accurate source of location information that is low cost and lightweight.

7. Claims 4, 5, 12 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Sakuma or Bar et al in view of Schilit et al.

8. Each of Sakuma and Bar et al teach the subject matter substantially as claimed as previously set forth above but fail to teach the various groupings and exclusions of the response information. Schilit et al teach a mobile distributed computing system that enables groups of users to be provided with downloaded information in response to a single user request as well as the ability to selectively exclude users from being tracked. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either one of Sakuma or Bar et al by including a list of subscribers/users in the inquiry in order to provide the location-based information to more than one member of an associated group in view of the teachings of Schilit et al. Moreover, it would have been obvious to selectively exclude certain users from being tracked in view of the teachings of Schilit et al.

9. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novik in view of .

Novik teaches the subject matter substantially as claimed including a plurality of mobile users that each send location information via a communication signal to a central station having a location database that tracks the mobile users. Each mobile user is provided with conventional communication means for bi-directionally communicating with the central station. The central station has a database for tracking all of the mobile users as well as provides location-based information to the mobile user. Thus, the mobile stations are capable of transmission and reception with the central station and vice versa. The central station is aware of the locations of all mobile users as well as sends location-based information to the users. Novik differs only in that the communication from a mobile user is not specified as a request for position of a second user. However, the first user is capable of communicating with the central station and requesting

any positional information, and, the central station is fully aware of the positions of all second users and sends position-based information to the first user. It would have been obvious to one having ordinary skill in the art given the system of Novik for the user of the first mobile to request positional data of a second mobile in the normal communication transfer between the first user and the central station in order for the first mobile to ascertain directions to meet up with the second mobile user for the purposes of exchanging packages during courier services or for meeting for lunch/dinner.

Applicants argue that claim 1 includes language that specifies a requesting user to obtain information of others based on its own information and that this is not shown in the prior art. Applicants allege that claims 2-16 are dependent upon claim 1 and as such are also allowable. Applicants also allege that each of the claims 20 and 23 also includes such a limitation. Firstly, the step of requesting information of another mobile user is not deemed to be patentable for reasons set forth above including the fact that all of the components are readily present in Novik. Contrary to the applicants' remarks, claim 14, an independent claim does not include such a request for information. Lastly, the central station does send the first mobile user positional information upon request; for the request to include a particular mobile user is not deemed to be patentably distinguishable over the prior art.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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11. Claims 7 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

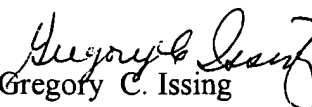
The language in claim 7, "wherein said transmitting comprises: calculating a distance" fails to clearly point out the subject matter since it is not clear how a step of transmission is capable of calculating a distance.

In claim 18, the language "a current location of said second mobile unit traveling from said processing station to said first unit" is not understood.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Gregory C. Issing  
Primary Examiner  
Art Unit 3662

gci  
September 30, 2002